

### REMARKS

The amendments to the specification and to the claims correct typographical errors. New dependent claims 34 and 35 recite further steps for separating oligonucleotides. No new matter has been added. Applicant respectfully requests reconsideration and allowance of claims 1-35 in view of the following remarks.

#### Rejections under 35 U.S.C. § 102

The Examiner rejected claims 1-33 as anticipated under 35 U.S.C. § 102(b) by Kwiatkowski et al., *Nucleic Acids Research*, 24(23): 4632-4638 (1996) and Kwiatkowski et al., WO 98/08857 (collectively "Kwiatkowski"). (OA at 2-3.) The Examiner asserted that each Kwiatkowski et al. reference "teaches a method for separating oligos comprising all of the limitations recited in claims 1-29" and "a composition comprising all of the limitations recited in claims 30-33." (*Id.*) Applicant respectfully disagrees.

The method and composition claims of the instant application each require a free *bifunctional* oligonucleotide with a separation tag at each end of the oligonucleotide. Claims 1 and 27 recite at step b) that the bifunctional oligonucleotide adheres to a separation medium. Claim 30 contains a similar recitation. (*See also*, page 8, lines 27-30 and page 15, lines 5-15 of the specification.) Kwiatkowski disclose free *monofunctional* oligonucleotides that have a single separation tag on one end of the oligonucleotide. (*See, e.g.*, Kwiatkowski et al., *Nucleic Acids Research*, at 4634; and WO 98/08857 at page 18, lines 1-5.) Thus, Kwiatkowski do not disclose or reasonably suggest the instant claims. Applicant respectfully requests withdrawal of the rejection of the claims under 35 U.S.C. § 102(b) over Kwiatkowski et al., *Nucleic Acids Research*, 24(23): 4632-4638 (1996) and Kwiatkowski et al., WO 98/08857.

The Examiner rejected claims 1-33 under 35 U.S.C. § 102(b) as being anticipated by Kwiatkowski et al., *Nucleic Acids Research*, 27(24): 4710-4714 (1999) ("Kwiatkowski 1999"). (OA at 3.) The Examiner asserted that the Kwiatkowski et al. reference "teaches a method for separating oligos comprising all of the limitations recited in claims 1-29" and "a composition comprising all of the limitations recited in claims 30-33." (*Id.*) Applicant respectfully disagrees.

The method and composition claims of the instant application each require a *free bifunctional*-oligonucleotide with a separation tag at each end of the oligonucleotide. (See, e.g., page 8, lines 27-30 and page 15, lines 5-15 of the specification.) Kwiatkowski 1999 discloses a process for synthesizing oligonucleotides in the 3' to 5' direction and then reversing the orientation of the oligonucleotides *in situ*, i.e., covalent linkage at or near the location where the oligonucleotide was formed. The Kwiatkowski 1999 process includes removing non-inverted material—a process that does not, however, include the production of a *free bifunctional*-oligonucleotide with a separation tag at each end of the oligonucleotide. Kwiatkowski 1999 does not disclose or reasonably suggest a *free bifunctional*-oligonucleotide with a separation tag at each end of the oligonucleotide adhering to a separation medium. Thus, Kwiatkowski does not disclose or reasonably suggest the instant claims. Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. §102(b) over Kwiatkowski et al., *Nucleic Acids Research*, 27(24): 4710-4714 (1999).

### CONCLUSION

In light of the above remarks and amendments, Applicants respectfully request allowance of claims 1-35. The Examiner is invited to telephone the undersigned agent if such would further prosecution. A check for the one-month extension of time is enclosed. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 4/1/09



Monica McCormick Graham, Ph.D.  
Reg. No. 42,600

Fish & Richardson P.C., P.A.  
60 South Sixth Street  
Suite 3300  
Minneapolis, MN 55402  
Telephone: (612) 335-5070  
Facsimile: (612) 288-9696